

REMARKS

This is a full and timely response to the non-final office action of March 31, 2004.

Reexamination, reconsideration and allowance of the application and all presently pending claims are respectfully requested. Upon entry of this response, claims 1-23 and 27-33 remain pending in this application. Claim 33 is newly added. It is believed that the foregoing amendments add no new matter to the present application.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, *e.g.*, *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Furthermore, the Federal Circuit has stated that “(i)t is impermissible, however, to simply engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (1991).

Claim 1

Claim 1 is not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Claim 1 reads as follows:

1. A method for printing information comprising:
storing information corresponding to a print task in memory in a print-ready format, such that information in the print-ready format can be printed by a printing device without being processed by a driver;
selecting a portion of the information in the print-ready format; and
enabling the selected portion of the information in the print-ready format to be printed without printing a non-selected portion of the information in the print-ready format. (Emphasis added).

Applicant respectfully asserts that the cited art is inadequate to render pending claim 1 obvious. In particular, the cited art fails to suggest or teach at least the features of pending claim 1 highlighted hereinabove.

Specifically, neither reference teaches the limitation of “enabling a selected portion of the **information in the print-ready format** to be printed **without printing a non-selected portion of the information in the print-ready format**,” as claimed in claim 1. (Emphasis added). Indeed, the Office Action states that “the examiner did not assert that the print task is ‘information in the print-ready format,’” but that the “system in *Housel* has an ability to select portions of a **print task** to be printed.” See Office Action at page 6. (Emphasis added).

Housel, the hypothetical system would apparently receive a selected portion, *i.e.*, “determine a pattern of media feeds for the pages of the print job.” See *Housel*, FIG. 3A step S16. Upon determination of a pattern of media feeds, the hypothetical system would then “determine media feed instructions for routing the pages of the print job between...the input sources...and the output sources.” See *Housel*, FIG. 3A, step S18. Thereafter, “the central processing unit 17 [of the hypothetical system] converts the information ...(organized in S16) into printer-readable language for the printer.” See *Housel*, page 4, paragraph 0052. Thus, the information to be printed is converted into a “print-ready format” *after* it has been selected by a user. Indeed, it is explicitly admitted on page 6 of the Office Action that the information from which a user selects a portion to be printed is not “in a print-ready format.” Therefore, the portion to be printed by the hypothetical system is not selected from information “in a print ready format,” as recited by claim 1.

Further, since it appears that the portion to be printed is selected from information not “in a print ready format” in the hypothetical system, it follows that the alleged “non-selected portion” is not in a “print ready format.”

For at least the above results, it does not appear that the alleged combination teaches or suggests “enabling a selected portion of the **information in the print-ready format** to be printed **without printing a non-selected portion of the information in the print-ready format**,” as claimed in claim 1. (Emphasis added).

Accordingly, Applicant submits that the Office Action fails to overcome its burden of establishing that each of the features in the combination highlighted hereinabove for claim 1 is suggested or taught by the cited art.

For at least the foregoing reasons, Applicant submits that the 35 U.S.C. §103 rejection of claim 1 is improper and should be withdrawn.

Claims 2-9 and 21-29

Claims 2-9 and 21-29 are not unpatentable under 35 U.S.C. §103 over *Mori* in view of *Housel*. Applicant submits that the pending dependent claims 2-9 and 21-29 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-9 and 21-29 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 10

Claim 10 is not unpatentable under 35 U.S.C. §103 over *Mori* in view of *Housel*. Previously presented claim 10 reads as follows:

10. A print system comprising:
 a job retention system configured to store print-ready information corresponding to a print task and to receive an input corresponding to a selected portion of the print-ready information, the print-ready information being configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device, the job retention system being further configured ***to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.*** (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that the cited art fails to suggest or teach at least the features of claim 10 highlighted hereinabove. Therefore, the 35 U.S.C. §103 rejection of claim 10 is improper and should be withdrawn.

Claims 12-20 and 30

Claims 12-20 and 30 are not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Applicant submits that the pending dependent claims 12-20 and 30 contain all features of their respective independent claim 10. Since claim 10 should be allowed, as argued hereinabove, pending dependent claims 12-20 and 30 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 31

Claim 31 is not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Claim 31 reads as follows:

31. A system, comprising:
a printing device having an input interface; and
a job retention system configured to receive and store print-ready information corresponding to a print task, the job retention system further configured to receive selection information from a user, via the input interface, and configured to select a portion of the print-ready information based upon the selection information, ***the job retention system further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.***

Applicant asserts that the cited art fails to disclose or teach each of the above features of claim 31.

Thus, claim 31 is allowable.

Claims 32

Claim 32 is not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Applicant submits that the pending dependent claim 32 contains all features of its respective independent claim 31. Since claim 31 should be allowed, as argued hereinabove, pending dependent claim 32 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 33

Newly added claim 33 reads as follows:

33. A printer system, comprising:
 memory configured to store print ready information indicative of a document to be printed; and
 job retention logic configured to receive a selection from a user indicative of a portion of the print task that the user desires to be printed, the job retention logic further configured to integrate with the print ready information a designation identifying the selected portion enabling the selected portion of the print ready information to be printed by a printing device without further translation by a printer driver.

Applicant submits that the combination of *Mori* and *Housel* does not teach or suggest the limitations of newly added claim 33. Thus, Applicant requests that newly added claim 33 be allowed.

Claim 34

Newly added claim 34 reads as follows:

34. A printing method comprising:
 receiving a print request;
 converting information corresponding to the print request from a format that is not print-ready into a print-ready format such that the converted information can be printed by a printing device without being processed by a driver;
 selecting a portion of the converted information subsequent to the converting; and
 enabling the selected portion of the converted information to be printed without printing a non-selected portion of the converted information.

Applicant submits that the combination of *Mori* and *Housel* does not teach or suggest the limitations of newly added claim 33. Thus, Applicant requests that newly added claim 33 be allowed.

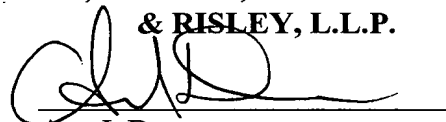
CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

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